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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,996	11/14/2001	Erwin Bauer	GR99P8059	5736

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EXAMINER

PEREZ, GUILLERMO

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,996

Applicant(s)

BAUER ET AL. 

Examiner

Guillermo Perez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballmann et al. (U. S. Pat. 5,887,553) in view of Voros, Jr (U. S. Pat. 3,670,188).

Ballmann et al. disclose an electromagnetic actuator, comprising:

at least one electromagnet (1) having a coil and a first contact surface;

a second contact surface;

at least one resetting device (3);

an armature (6) having a shank (5) mechanically coupled to the resetting device (3), the armature (6) being movable between the first contact surface on the electromagnet (1) and the second contact surface. Ballmann et al. disclose an electromagnetic actuator assembly, comprising:

at least one electromagnet (1) having a coil and a first contact surface;

a second contact surface;

at least one resetting device (3);

an armature (6) having a shank (5) mechanically coupled to the resetting device (3), the armature (6) being movable between the first contact surface on the electromagnet (1) and the second contact surface;

a support (between 3 and 2) mounting the electromagnet (1) and the armature (6).

However, Ballmann et al. do not disclose a connector having at least one contact element electro-conductively connected to the coil of the electromagnet, the contact element to be electrically contacted by an assembly-contacting element, upon the connector engaging a connector receptacle. Ballmann et al. do not disclose that the support having a contacting element. Ballmann et al. do not disclose a connector having at least one contact element electro-conductively connected to the coil of the electromagnet and in electrical contact with the contacting element.

Ballmann et al. do not disclose that the connector has an opening formed therein, and the contact element has a region configured as a service contact which is led through the opening in the connector and the service contact, at least during the assembly of the actuator onto the support, can be electrically contacted by the assembly contacting element. Ballmann et al. do not disclose that the connector has a housing with the opening formed therein, the service contact is led in an oil-proof manner through the opening in the housing of the connector.

Voros, Jr discloses a connector (24) having at least one contact element (29) electro-conductively connected to the coil (8) of the electromagnet. Voros, Jr discloses that the support (2) having a contacting element (29). Voros, Jr discloses a connector

(24,27,28,38,39) having at least one contact element (29) electro-conductively connected to the coil (8) of the electromagnet and in electrical contact with the contacting element (29).

Voros, Jr discloses that the connector (24) has an opening (*where the screw is located*) formed therein, and the contact element (29) has a region configured as a service contact (23) that is led through the opening (*where the screw is located*) in the connector (24) and the service contact (23) can be electrically contacted by the assembly-contacting element (i.e. a screwdriver not shown). Voros, Jr discloses that the connector (24) has a housing (2) with the opening formed therein, the service contact (23) is led in an oil-proof manner through the opening (*where the screw is located*) in the housing (2) of the connector (24). The invention of Voros, Jr has the purpose of providing a pair of normally open electrical contacts so assembled that they may be simply plugged into a socket and extracted therefrom when replacement is necessary.

It would have been obvious at the time the invention was made to modify the actuator of Ballmann et al. and provide it with the connection configuration for the purpose of providing a pair of normally open electrical contacts so assembled that they may be simply plugged into a socket and extracted therefrom when replacement is necessary.

Referring to claims 1-3 and 5, no patentable weight has been given to the method of manufacturing limitations (i. e. "causing the contact element to be electrically contacted by an assembly contacting element, even upon said connector engaging a connector receptacle" emphasis added) since "even though product-by-process claims

are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Arguments

Applicant's arguments filed May 9, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the “connector receptacle is not claimed as part of the actuator per se”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's remark that Ballmann does not disclose a connector having at least one contact element electro-conductively connected to the coil of the electromagnet and configured to cause the contact element to be electrically contacted by an assembly-contacting element and also to be engaged with a connector receptacle, it must be noted that Voros discloses those limitations.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., "plug-like connector", "plug-connector receptacle") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's remark that there is no disclosure of a contact element that is electrically contactable by an assembly-contacting element, it must be noted that Voros discloses a contact element (screw 29) that is electrically contactable by an assembly-contacting element (a screwdriver or other tool used to tighten the screw 23 shown in figures 1-3), as claimed.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Voros teaches that providing its connection arrangement to an actuator like the one disclosed by both Ballmann and Voros will provide a pair of normally open electrical contacts so assembled that they may be simply plugged into a socket and extracted therefrom when replacement is necessary (column 1, lines 9-13 of Voros).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Guillermo Perez whose telephone number is (703) 306-5443. The examiner can normally be reached on Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308 1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305 3432 for regular communications and (703) 305 3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.

Guillermo Perez
Thursday, August 07, 2003

Thomas M. Ougherty
REGISTERED PATENT ATTORNEY
AUGUST 8 2003